

REMARKS

The Office Action mailed November 16, 2005 has been carefully considered. Claims 1-8 are now cancelled, and the Applicant has amended Claims 9 and 16. The Applicant has added new claims 25-29. Reconsideration in view of the above amendments and following remarks is respectfully requested.

Rejection Under 35 U.S.C. § 112

Claims 1, 2, 4-6, 8, and 16-23 were rejected under 35 U.S.C. § 112 as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter. The Applicant has amended Claim 16 to correct the antecedent basis error and has cancelled Claim 1, 2, 4-6 and 8. Accordingly, Claims 16-23 now overcome the rejection and are in a condition for allowance.

Rejection Under 35 U.S.C. § 103(a)

Claims 1, 2, 4-10, and 12-23 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Fuller et al., U. S. Patent 5,768,605 (hereinafter referred to as Fuller) in view of Johnson et al., U.S. Patent 6,573,868 (hereinafter referred to as Johnson) among which claims 1, 9 and 16 are independent claims. This rejection is respectfully traversed.

Claims 1, 2, 4-8 have been cancelled as stated above. Therefore, the rejection to these claims is now moot.

Fuller merely discloses a PCMCIA card which has a switch, whereby a connector 364 receives a communication cable 368 when the connector 364 is at an extended position. Fuller describes that when the connector 364 is in the extended position, node A 382 is decoupled from node B 381, whereby voltage is provided to the card 340. In contrast, when the connector 364 is

in the retracted position, node A 382 is coupled to node B 381, whereby voltage is not provided to the card 340. As recognized in the Office Action, Fuller does not recite an antenna nor that the inserted or removed signal is based on the position of the antenna. However, the Office Action tries to maintain that one skilled in the art would combine Johnson with Fuller to reach the claimed invention(s).

Johnson only discloses an antenna which is able to move between an extended and retracted position, whereby power is provided to the antenna when the antenna is extended. Contrary to the argument set forth in the Office Action, Johnson does not teach generating a signal based on the position of an antenna whether to supply power to the peripheral device. Instead, Johnson discloses that power is terminated only to the antenna when the antenna is retracted. (emphasis added). Thus, there is no hint, teaching, or suggestion in Johnson that power is terminated to the peripheral device and the antenna when the antenna is retracted, as in the claimed invention(s). (emphasis added).

In fact, Johnson, in its entirety, teaches away from the notion that power is terminated to the peripheral device and the antenna when the antenna is retracted. Johnson expressly states that the user may continue to use the electronic device and its features even though the antenna is non-functional and wireless communication is unavailable. (Johnson, Col. 4, Lines 4-10; Col. 12, Lines 58-60). Accordingly, it would not be obvious for one skilled in the art to combine Johnson with Fuller to reach the present invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983) (“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.”)

Claim 9 recites, among other things, that the switch causes the host device to terminate power to the peripheral device and antenna. In addition, Claim 16 recites, among other things, that the host device does not power the peripheral device and the antenna when the antenna is

retracted. Further, new Claim 25 recites, among other things, that host device does not provide power to the peripheral device and the antenna in response to the removed signal. As stated above, Johnson does not teach generating a signal based on the position of an antenna whether to supply power to the peripheral device. Instead, Johnson teaches away from this notion, because Johnson expressly states that control switch still allows the other features of the peripheral device to be utilized even though the antenna is retracted. For at least these reasons, one skilled in the art would not find it obvious to combine Johnson with Fuller to reach the claimed invention(s) in Claims 9, 16 and 25. Therefore, Claims 9, 16, and 25 are allowable over Fuller and Johnson, individually or in combination.

Claims 10, 12, 13, and 17-23 have been rejected as being unpatentable over Fuller in view of Johnson. However, Claims 10, 12, and 13 are dependent on Independent Claim 9 and Claims 17-23 are dependent on Independent Claim 16. For at least the reasons stated above, Claims 9 and 16 are allowable over Fuller and Johnson, individually or in combination. Accordingly, Claims 10, 12, 13, and 17-23 are allowable as being dependent on allowable base claims.

New Claims

The Applicant has added new Claims 25-29 and submits that the claims are fully supported by the specification and do not contain new matter. Independent Claim 25 is allowable for at least the reasons stated above. In addition, Claims 26-29 are dependent on Claim 25 and are thus allowable for being dependent on an allowable base claim.

Conclusion

It is believed that the amendment and remarks place the above-identified patent application into condition for allowance. Early favorable consideration of this response is earnestly solicited.


If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

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